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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,813	02/05/2004	Kim D. Gooding	CO/2-22844/A/CGC 2143	5963

324 7590 07/15/2005

CIBA SPECIALTY CHEMICALS CORPORATION  
PATENT DEPARTMENT  
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EXAMINER
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MANLOVE, SHALIE A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/772,813

Applicant(s)

GOODING ET AL.

Examiner

Shalie A. Manlove

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/20/04, 10/1/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Election/Restrictions***

**DETAILED ACTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6 and 10-17, drawn to pigment, classified in class 106, subclass 493-497, 499.
  - II. Claims 7-9 and 18-21, drawn to process, classified in class 427, subclass 331+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using such as in color filters, or color toners, and printing inks.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Shelia Loggins on June 20, 2005 a provisional election was made with traverse to prosecute the invention of pigment, claims 1-6 and 10-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-9 and 18-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6, 10-12, 15, and 17 rejected under 35 U.S.C. 102(b) as being anticipated by Kershaw et al US 3,839,253.

With respect to claims 1 and 10, Kershaw teaches a coating composition comprising latex and colorant granules that do not dissolve (abstract; col. 4, lines 66-col. 5, line 2).

As to claims 2, 11 and 17, Kershaw teaches the coating composition dries to a matte film of uniform visual appearance and good mar resistance (col. 1, line 43- col. 2, lines 30), which indicates that the aqueous coating is a homogenous blend of a coloring agent and a urea-formaldehyde resin (col. 3, lines 64-col. 4, lines 2; and line 27-45).

As to claims 3-4, 6, 12 and 15, Kershaw teaches the coating composition to comprise an organic pigment, an inorganic pigment, or a dye (col. 4, lines 27-41).

7. Claims 1-6, 10-12, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Creusen et al EP 1 277 808 A2

With respect to claims 1 and 10, Creusen teaches a pigment composition comprising pigment and urea-aldehyde resin, which does not dissolve (abstract).

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As to claims 2, 11, and 17, Creusen teaches the pigment composition is a homogenous blend of a colorant and a urea-aldehyde resin (abstract; 0001).

As to claims 3-4, 6, 12, and 15, Creusen teaches the pigment composition to comprise an inorganic pigment, organic pigment, dye or mixtures thereof (0015-0019).

As to claims 5 and 16, Creusen teaches the composition consists essentially of pigment and urea-aldehyde resin wherein the weight ratio of pigment to urea-aldehyde resin is in the range of 40:60 to 90:10 (abstract; 0013).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-6 and 10-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-5, 7 and 10 of U.S. Patent No. 6,734,231. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application and the patent teach a similar composition comprising a coloring agent and urea-aldehyde resin.

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***Conclusion***

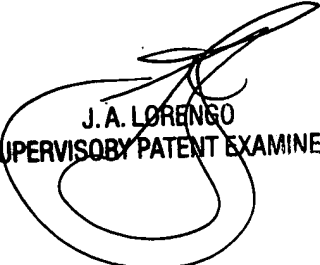
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (571) 272-1372. The examiner can normally be reached on M-TH 6:30-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shalie A. Manlove  
Examiner  
Art Unit 1755

July 5, 2005

  
J.A. LORENZO  
SUPERVISORY PATENT EXAMINER